REMARKS

This responds to the Office Action dated August 10, 2007.

Claims <u>1-13 and 16-24</u> are now pending in this application.

§103 Rejection of the Claims

Claims 1-13 and 16-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson et al. (U.S. Patent No. 6,549,894) in view of Lee et al. (U.S. Patent No. 6,839,707).

Applicant has studied the examiner's rejection and respectfully disagrees with the examiner's characterization of Simpson. Applicant amended the claims in the prior amendment to included, "a messaging module operable to provide messaging to users of the system, wherein the messaging comprises automated messages to particular users, the messages relating to matters and tasks associated with the particular users and stored in a manner searchable and retrievable by matter." The examiner states that this element is taught in Simpson on column 5, lines 5-67. The messaging module of Applicants invention operates to send a message to a user regarding a matter. Simpson provides docket report that provides a list of activities or tasks with color-coded graphics to indicate upcoming due dates in the same manner as a printed docket report. Simpson claims his improvement is a docket report in an electronic format so that the report is always current. Simpson does not contemplate sending messages to users relating to matters and tasks associated with a particular user and does not teach storing that message in a database that is searchable and retrievable for a matter. While the docket report presented in Simpson may be for a user, there is no indication that the docket report presented is stored, in fact as Simpson points out docket reports need to fluid to avoid out of date data being presented. See Simpson column 5 lines 54 – 57. Applicant submits that Simpson is not teaching a messaging module as taught by applicant but a real time docket report.

With respect to the examiner's characterization of Figures 1, 2 and 4 stating that Lee discloses "a security module, the security module to restrict Internet access to a patent application task and matter data management to selected system users." Applicant submits that Lee is ambiguous with respect to the rights granted to a user. Figures 1 and 2 are standard well known networking models and are not specific as to the user's rights. Element 182 of Lee

discusses user's permissions. Lee states, "to alter the user's permission, the administrator chooses the appropriate application menu and selects the new permission level." There is no indication if this is with respect to the system in general or to a patent application as claimed by Applicant. Therefore, Applicant submits that there is no teaching of a security module in Lee as contemplated and claimed by applicant. Applicant therefore, submits in light of these arguments claim 1 is now in allowable form. As all of the claims now pending are dependant upon claim 1, applicant submits that claims 2-13, and 16-24 are now also in allowable form.

With respect to claim 17 in addition to the arguments above applicant submits that the Examiner is reading into Lee functionality and features that do not exist. The examiner further relies upon Lee to teach the messaging system referencing Fig. 4 of Lee. Applicant believes the examiner is referencing element 146. Element 146 as stated by Lee, "Content Management module 146 allows a non-technical user without HTML knowledge to attach, delete, and modify documents...Content Manager 146 permits the user to Upload or Delete Files, Links, and E-mails depending on the user's needs. See Lee column 7 lines 14 – 19. Neither Lee nor Simpson has an automated means to send messages to a user and store it in a manner that it is retrievable by the matter. Lee only lists e-mails as an attachment that may be copied into the storage by the user similar to any other document and not by an automated system.

Further, with respect to claim 17, Lee does not contemplate "a messaging module that is further operable to send electronic mail to users". Lee does not contemplate sending e-mails, only storing them. As stated in the prior response, to form a proper rejection under 35 U.S.C. §103, the reference (or references when combined) must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). The mere showing of a system that in some way interacts with E-mail as shown in Lee does not show the element as claimed. The Examiner must show all of the elements as claimed, including the actual sending and storing of e-mails with respect to a patent matter in a searchable format.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with

this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/872,701
Filing Date: June 1, 2001
Title: INTERNET-BASED PATENT AND TRADEMARK APPLICATION MANAGEMENT SYSTEM

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6938 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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